



PATENT APPLICATION
CS8429
LeA 36,272

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION OF)	
)	
KATSUAKI WADA ET AL)	GROUP NO.: 1626
)	
SERIAL NO.:10/517,859)	
)	
FILED: AUGUST 16, 2005)	EXAMINER: Y. L. CHU
)	
TITLE: NOVEL PHTHALAMIDE)	
DERIVATIVES)	

COMMUNICATION TO ACCOMPANY PAYMENT OF ISSUE FEE REGARDING

UNINITIALED PTO FORM 1449

AND/OR

AMENDMENT PURSUANT TO 37 C.F.R SECTION 1.312

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

The issue fee is due in this application on or before September 23, 2006.
Applicants are filing this communication concurrently with the payment of the issue fee. No fee is believed to be due in connection with this filing, but if a fee is due, the U.S. Patent Office is hereby authorized to charge any necessary fee to Deposit Account No. 50-2510.

I hereby certify that this correspondence is being deposited with the
United States Postal Service as first class mail in an envelope addressed
to: Commissioner for Patents, Alexandria, VA 22313-1450, on

8/23/06

Date

Richard E. L. Henderson, Reg. No. 31,619

Name of applicant, assignee or Registered Representative

Richard E. L. Henderson

Signature

August 23, 2006

Date

Applicants have styled this paper in the alternative in the hope that the matter it raises may be addressed as a simple communication to accompany payment of the issue fee or if necessary as an amendment pursuant to 37 C.F.R. Section 1.312.

The gist of this communication is that although Applicants properly cited certain art in a PTO Form 1449 filed with this case on September 7, 2005, and have received the Notice of Allowability and the Notice of Allowance, Applicants have not received a fully initialed PTO Form 1449 from the Examiner. Applicants prefer to have the references cited in the ISR printed on the face of the issuing patent and are aware of the requirement to file a Form PTO 1449.

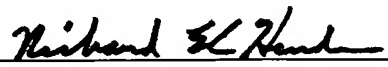
Applicants enclose herewith a copy of the Form PTO 1449 as filed on September 7, 2005, listing under "Foreign Patent Documents" five documents on Page 1 of 2 and one document on Page 2 of 2. In the copy of Form PTO 1449 returned with Notice of Allowability and the Notice of Allowance (also enclosed), these six documents were crossed out, indicating that they may not have been considered during examination.

The first two documents AL and AM listed on Page 1 of 2 relate to known background art: DE 2,045,905 (document AL) was cited in the specification at page 11, line 15, as describing a known preparation of compound (III) and JP 61-246161 was cited in the specification at page 9, line 8, as relating to compound (V). Although only English abstracts were provided by Applicants, no reason was given for not considering the references or abstracts for what they teach.

Documents AN, AO, and AP listed on Page 1 of 2 and document AL on Page 2 of 2 (i.e., WO 02/094765, EP 1241159, DE 10115406, and EP 1193254) were clearly identified by double asterisk (**) as documents for which copies were previously submitted to WIPO. Furthermore, Form PCT/DO/EO/903 ("371 Acceptance Notice") clearly indicates receipt of the International Search Report in which these four documents were cited and identified as having been provided to the International Bureau. It is the Examiner's obligation to consider all of the art cited in the International Search Report and to indicate in the first Office Action that the information has been considered. See MPEP 609.03 ("Information Disclosure Statements in National Stage Applications").

Applicants therefore respectfully request that this application be returned to the Examiner to (1) consider these references; (2) initial the relevant references in the Form PTO 1449; and (3) have the references printed on the face of the issuing patent.

Respectfully submitted,

By 
Richard E. L. Henderson
Attorney for Applicant(s)
Reg. No. 31,619

Bayer CropScience LP
100 Bayer Road
Pittsburgh, Pennsylvania 15205-9741
PHONE: (412) 777-3809
FACSIMILE PHONE NUMBER:
412-777-3902
s/rmc/rejh/0668

Notice of Allowability

Application No.

10/517,859

Examiner

Yong'Chu

Applicant(s)

WADA ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9/15/2005.
2. ☒ The allowed claim(s) is/are 11-18.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. JP180028.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 9/12/2005
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 6/5/2006
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION

Claims 1-10 are cancelled by amendment filed on 16 September 2005. Claims 11-19 are added by amendment filed on 16 September 2005. Therefore, claims 11-19 are currently pending in the instant application.

Information Disclosure Statement

Applicant's Information Disclosure Statements, filed on 12 September 2005, have been considered. Please refer to Applicant's copies of the PTO-1449 submitted herewith.

Priority

This application is a 371 national stage of PCT/EP03/06105, filed on 11 June 2003. Applicants claim the benefit of Japan Patent Application 2002-180028 filed on 20 June 2002.

Response to Amendment

The Supplementary Amendment by Applicants' representative Richard Henderson dated on 16 September 2005 has been entered.

Examiner's amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided

Art Unit: 1626

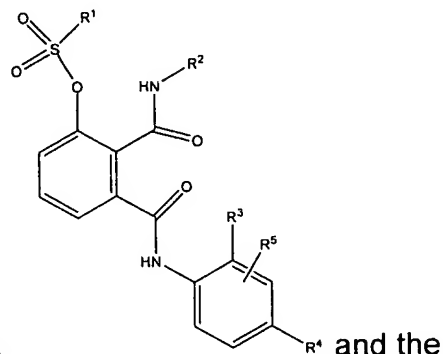
by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

Delete claim 19 of the Supplementary Amendment dated on 16 September 2005.

Reasons for Allowance

The present invention is directed to a compound, an insecticidal composition

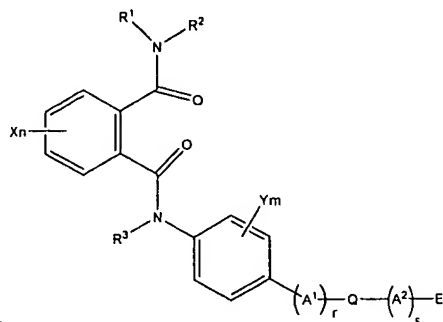


containing one or more phthalamide compounds

methods to make and to use the compounds or composition for treating insect. The closest prior arts of record are co-pending U.S. Patent Applications 10/549,080, and 10/475,592 with the same assignee.

CS 8619

U.S. Patent Applications 10/549,080 (Wada) discloses a phthalamide compound



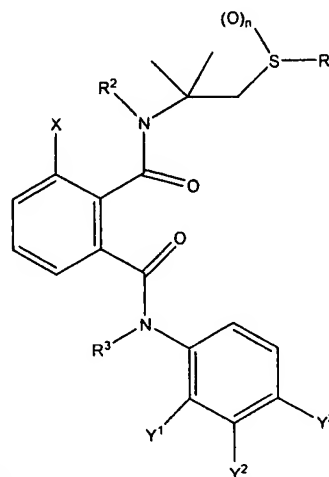
of general structure

, which has provisional Double

Art Unit: 1626

Patenting claims over the instant application. However, the current application is a senior case with earlier filing date, and can be allowed to become patent, and the junior one 10/549,080 (Wada) need to be amended to avoid Double Patenting MPEP §804 (I) B(1).

U.S. Patent Applications 10/475,592 (Harayma *et al.*) with common inventor



(Rudiger Fisher) discloses a phthalamide compound

is defined as halogen, which is distinct from the current application.

wherein X

Therefore, claims 11-18 are allowed.

Telephone Inquiry


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone

Art Unit: 1626

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yong Chu, Ph.D.
Patent Examiner
Art Unit 1626

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER

Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626

Interview Summary	Application No.	Applicant(s)	
	10/517,859	WADA ET AL.	
	Examiner	Art Unit	
	Yong Chu	1626	

All participants (applicant, applicant's representative, PTO personnel):

(1) Yong Chu. (3)_____

(2) Richard Henderson. (4)_____

Date of Interview: 05 June 2006.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: _____

Claim(s) discussed: 19.

Identification of prior art discussed: None.

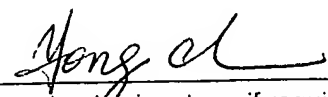
Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A..

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Examiner suggests to cancel claim 19, because this claim is related to intermediate compounds and structually distinct from the final compound in claim 1, and many intermediates are known. Applicants agreed with the Examiner to cancel claim 19 by Examiner's Amendment.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.


Examiner's signature, if required